

REMARKS

After careful review of the cited references, Applicants respectively request reconsideration in view of the above amendments and following remarks.

CLAIM REJECTIONS

In the Office Action mailed December 23, 2004, the Examiner rejected claims 1, 6, 11, 15, 16, 17 under 35 U.S.C. § 103(a) as being unpatentable over Hinri et al (6,731,609) in view of Meredith et al (5,426,510). Claims 2-5, 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hinri et al and Meredith et al and further in view of Rogers et al (6,785,379 B1). Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hinri et al and Meredith et al and further in view of Sladek et al (6,622,016).

THE PRESENTLY CLAIMED INVENTION

Claims 11-14 have been deleted and claims 1, 6, 15, 16, and 17 have been amended.

Applicants' presently claimed invention allows callers on a multi-party conference call to set up a private call session or temporary "sidebar" conference outside the on-going conference. The temporary sidebar conference call cannot be heard by other callers. The sidebar participants can speak to each other and still hear all the participants on the conference call. The other participants on the conference call can hear each other, however, they cannot hear the sidebar conversation.

In the preferred embodiment, the audio streams from the conference call are diverted to a temporary sidebar conference connection. Thus, users of the private sidebar can then still hear the conference call, yet converse with each other on the temporary conference without the

affecting the on-going conference call. Claim 1, for example, is directed to a method of establishing an sidebar conference between at least two users, by creating the temporary sidebar conference, directing the audio stream of the first conference to the sidebar conference, directing the audio stream of the first and second user to the sidebar conference wherein the audio stream of the first and second users are only audible to the first and second user.

THE CITED PRIOR ART

Hinri et al teaches a multimedia telephonic communications system capable of establishing multi-party conference calls as shown in Figs. 2A and 2B. Hinri has a “Transfer to Device” function to transfer a telephone call from one endpoint device to another device. (Col. 10, lines 60-62). Hinri also has a “Mute Conference” ability to mute one of the parties on the call so that the party cannot hear the call. (Col. 10, lines 63-67). Hinri, however, does not show “creating a temporary conference” and “directing the audio stream of the conference to the sidebar conference” such that callers may have a private sidebar that other callers cannot hear, yet they can still hear the on-going conference.

Meredith et al teaches an audio-video system for use in a courtroom. The audio-video system includes cameras and microphones with “recorders to selectively record the signals emanating from the cameras and microphones.” (Col. 3, lines 6-11). Meredith has an “audio inhibition” or mute function to allow the attorneys to gather at the judge’s position 14 and have a face-to-face “sidebar” conversation without the conversation being amplified throughout the courtroom. A mute controller 62 “inhibit[s] the audio signal from being applied to amplifier 162” and being impressed upon the speaker 164-178” in the courtroom. (Col. 9, lines 15-27).

THE COMBINATION OF HINRI AND MEREDITH DOES NOT RESULT IN THE CLAIMED INVENTION

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest all the claim limitations, and there must be some suggestion or motivation to combine or modify the cited references. (MPEP § 2142). Applicants submit that neither Hinri nor Meredith, separately or in combination, teach or suggest (1) “creating a temporary conference;” (2) “directing the audio stream of the conference to the sidebar conference; (3) and “directing the audio stream of the second user to the temporary conference, wherein the audio stream of first user and the audio stream of the second user are only audible to the first and second user” as required by independent claims 1 and 6.

Hinri teaches “establishing a conference” setting up a call connection with respect to the description of Fig. 2A and 2B to carry the audio of a conference call connection. Hinri does not, however, teach “creating a temporary conference” and then “directing the audio stream of the conference to the sidebar conference.” First, Hinri only teaches setting up a conference in Fig. 2A or a multi-party conference in Fig. 2B. Hinri does not teach subsequently creating the temporary conference and directing the audio from the conference to the temporary conference to provide the sidebar that cannot be heard by the conference participants as called for by the claims 1 and 6. The transfer function of Hinri (col. 10, lines 60-62) is a feature that switches the call to another endpoint. In contrast, the claimed invention keeps the same endpoints, yet creates a temporary conference between the same endpoints. Further, the “Mute Conference” function of Hinri cuts off a caller from the conference call so that the caller cannot hear the call at all. The “Mute Conference” function does not direct the audio streams to a temporary conference so that the conference can be heard, yet the private sidebar be held as in the presently claimed

invention. Rather, the “Mute Conference” simply cuts the party off from the conference call so that it can hear no part of the call.

Meredith is simply a courtroom video and sound system amplification and recording system that does not establish call connections as set forth in the pending claims, much less transfer audio streams to a temporary connection. Meredith does not teach “directing the audio stream of the second user to the temporary conference, wherein the audio stream of first user and the audio stream of the second user are only audible to the first and second user.” The audio inhibition disclosed by Meredith is simply a mute function to prevent a face-to-face sidebar discussion had between the lawyers and the judge at the judge’s position 14 from being amplified over the courtroom speakers. (Col. 9, lines 15-27). Meredith is not relevant to providing audio streams from a call connection to a temporary call connection so that a limited number of participants can converse between themselves while still hearing the main conference. Meredith does not address call conferences, rather is a local audio and video amplification and recording system.

Since the proposed combination of Hinri and Meredith does not teach or suggest all of the limitations of independent claims 1, 6, 15, 16 and 17, the asserted combination does not obviate claims 1, 6, 15, 16 and 17. Dependent claims 2-5, and 7-10 depend from allowable claims 1 and 6 are likewise allowable as well.

**THERE IS NO SUGGESTION WITHIN EITHER
HINRI OR MEREDITH TO MAKE THE ASSERTED COMBINATION**

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. (MPEP §2143). Thus, “[i]n determining the propriety of the Patent Office case for obviousness in the

first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” (MPEP §2143.01). Consequently, to make a successful §103(a) obviousness rejection, the Office must show some objective teaching in the prior art or explain how one of ordinary skill in the art would be motivated to combine the relevant teachings. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Applicants submit that there is no teaching or suggestion within either Hinri or Meredith to make the proposed combination. Meredith is not in the “same field of endeavor” as Hinri and not relevant to Applicants’ presently claimed invention. Applicants’ invention and Hinri provide call conferencing connections for users who are in different locations to converse over a telephone-like voice or video call connection using a packet based network with computers and software. In contrast, Meredith is simply a courtroom audio/video amplification and recording system. Meredith provides sight and sound amplification and reproduction within a common single setting, a courtroom. Meredith is not relevant to the problem Hinri addresses, providing for conference call connection capability from remote participants. Thus, there is no showing that one skilled in the art would be motivated to combine the two dissimilar references.

Applicants submit that the Office has not shown some objective teaching in the cited references or explained how one of ordinary skill in the art would be motivated to combine the relevant teachings. Since there is no suggestion or motivation to combine Hinri and Meredith to render claims 1-10 and 15-17 obvious, the combination is improper for this rejection. Thus, the rejection of claims 1-10 and 15-17 over the combination of Hinri and Meredith should be withdrawn for this reason as well.

CONCLUSION

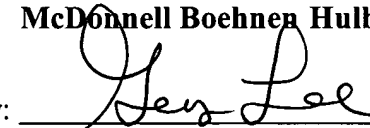
Applicants respectively submit that in view of the remarks above, all of the pending claims are in condition for allowance and such action is respectively requested. The Examiner is invited to call the undersigned at (312) 913-0001 with any questions or comments.

Respectfully submitted,

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